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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/792,110 | 03/02/2004 | William Swanson | 21947-305 | 3781 |
| 37374 | 7590 | 08/03/2009 | | |
| INSKEEP INTELLECTUAL PROPERTY GROUP, INC | | | | |
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| TORRANCE, CA 90504 | | | | |
| EXAMINER | | | | |
| SEVERSON, RYAN J | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3731 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 08/03/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

inskeepstaff@inskeeplaw.com

Office Action Summary

Application No.

10/792,110

Applicant(s)

SWANSON ET AL.

Examiner

Ryan J. Severson

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-39 and 41-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 19-36 and 42-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 11, 13-18, 37-39 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/22/2009 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 10, 11, 13-18, 37-39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altman (WO 01/26585) in view of Girouard et al. (2003/0069606).** Altman discloses a method of treating atrial arrhythmia, the method including delivering an unexpanded implant (see page 7, lines 5 and 6) expanding the implant (see page 8, lines 1-5) such that the implant migrates into the wall of the vein (the barbs migrate into the vein walls). By implantation of the stent, the stent forms a conduction block to isolate or block the electrical impulses of the pulmonary veins from

the atrial conduction tissue. The barbs can form scar tissue that also blocks the electrical impulses.

4. However, Altman does not disclose the treatment creates circumferential scar tissue. Attention is drawn to Girouard et al. who teach creating circumferential scarring (see paragraph 13) to eliminate a conduction pathway between the vein and the left atrium. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to have created circumferential scarring upon implantation and expansion of the stent of Altman in the manner taught by Girouard et al. to eliminate a conduction pathway between the vein and the left atrium.

Response to Arguments

5. Applicant's arguments filed 5/22/2009 have been fully considered but they are not persuasive.

6. Applicant argues one of ordinary skill in the art would not combine the cited reference because Altman desires to treat the arrhythmia would damaging tissue. However, Examiner notes at page 10, lines 9-21 of Altman that lesions can be created on the tissue to assist in treating arrhythmia, and therefore this argument is not persuasive.

7. Applicant argues the combination fails to disclose the implant migrating substantially through the wall of the pulmonary vein. However, it is the Examiner's position that as the implant expands, the barbs of Altman will migrate at least *substantially* through the wall. Further, Examiner considers it obvious to design the

barbs on the implant to penetrate entirely through the wall to provide the most secure anchoring of the implant as possible. Further, paragraph 14 of Girouard et al. makes clear that the stent itself can create the lesions.

8. Examiner also considers the barbs of the implant the second component and the implant itself the first component. The barbs expand into the tissue wall faster and before the implant does as they reach the tissue wall before the implant to securely anchor the implant at the treatment site.

9. Therefore, the arguments in total have been deemed not persuasive, and the rejection is maintained.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J. Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:30-5:00.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. S./
Examiner, Art Unit 3731
7/29/09

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731